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ATTORNEY DOCKET NO. 10003416-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Glenn R. Engel, et al.

Serial No.: 09/891,712 **Examiner: Niketa Patel**

Filing Date: June 25, 2001 **Group Art Unit: 2181**

Title: Configuring Network Devices

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on November 28, 2008 .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **$540.00.**

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for the total number of months checked below:

☐	one month	$ 120.00
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☐	three months	$1020.00
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☐ The extension fee has already been filled in this application.

☐ (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **50-1078** the sum of $540.00 . At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account **50-1078** pursuant to 37 CFR 1.25.

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Respectfully submitted,

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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Appl. No. : 09/891,712
Applicant(s): Glenn R. Engel, et al.
Filed: June 25, 2001
TC/A.U.: 2100/2181
Examiner: Niketa I. Patel
Atty. Docket: 10003416-01
Confirmation No.: 1807
Title: CONFIGURING NETWORK DEVICES

APPEAL BRIEF

Honorable Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In connection with the Notice of Appeal dated November **28, 2008**, Applicants provide the following Appeal Brief in the above-captioned application.

1. Real Party in Interest

The real party in interest as assignee of the entire right and title to the invention described in the present application is Agilent Technologies, Inc., having a principle place of business at 5301 Stevens Creek Blvd, Santa Clara, CA USA.

2. Related Appeals and Interferences

There are no known related appeals or interferences at this time.

3. Status of the Claims

Claim 21-36 are pending in this application. Claims 1-21 are cancelled. Claims 21-36 are the subject of the present Appeal. Claims 21=36 are finally rejected, and are duplicated in the Appendix.

4. Status of the Amendments

A final Office Action on the merits was mailed on July 9, 2008. A Reply under Rule 116 was filed on September 9, 2008, and according to the Advisory Action dated October 9, 2008, was entered into the record. There are no pending amendments with respect to this application.

5. Summary of the Claimed Subject Matter[1]

With reference to claim 21:

In a representative embodiment, a system for configuring a network device (e.g., 40 shown in Fig. 4) coupled to a local network (e.g., 50 shown in Fig. 4). The system comprises a configuration server (e.g., 10 shown in Fig. 4) coupled to a network (e.g., 30

[1] In the description to follow, citations to various reference numerals, drawings, and corresponding text in the specification are provided solely to comply with Patent Office rules. It is emphasized that these reference numerals, drawings, and text are representative in nature, and not in any way limiting of the true scope of the claims. It would therefore be improper to import anything into any of the claims simply on the basis of illustrative language that is provided here only under the obligation to satisfy Patent Office rules for maintaining an Appeal.

shown in Fig. 4). The configuration server (10) generating a web page (e.g., 60 shown in Fig. 3) that enables access to a configuration applet (e.g., 20 shown in Fig. 4). The system comprises a node (e.g., 12 shown in Fig. 4) coupled to the network (30) and the local network (50). The node (12) includes a web browser (e.g., 22 shown in Fig. 4) that enables a user to load the configuration applet (20) from the configuration server (10) onto the node (12) via the network (30) by accessing the web page (60) such that the configuration applet (20) when executing on the node (12) searches the local network (50) for the network device (40). The web browser (22) enables the user to generate a set of network configuration parameters (e.g., 64 shown in Fig. 3) for the network device (12) under control of the configuration server (10) by communicating with the configuration server via the network (30). (Kindly refer to claim 21; Figs. 1, 3 and 4; page 5, line 3 through page 6, line 20; and page 7, line 28 through page 10, line 31 of the filed application for additional details.)

With reference to claim 29:

In accordance with a representative embodiment, a method for configuring a network device (e.g., 40 shown in Fig. 4) coupled to a local network (e.g., 50 shown in Fig. 4), comprises: generating a web page (e.g., 60 shown in Fig. 3) that enables access to a configuration applet (e.g., 20 shown in Fig. 4) via a network (e.g., 30 shown in Fig. 4). The method also comprises loading the configuration applet (20) via the network (30) by accessing the web page (60) such that the configuration applet (20), when executing, searches the local network (40) for the network device (50). The method also comprises generating a set of network configuration parameters (e.g., 64 shown in Fig. 3) for the network device (40) under control of a configuration server (e.g., 10 shown in Fig. 4) by communicating with the configuration server (10) via the network (30). (Kindly refer to claim 29; Figs. 1, 3 and 4; page 5, line 3 through page 6, line 20; and page 7, line 28 through page 10, line 31 of the filed application for additional details.)

6. Grounds of Rejection to be Reviewed on Appeal

The issues in the present matter are whether:

I. Claims 21-27 and 29-35 are properly rejected under 35 U.S.C. § 103(a) in view of *Mendez, et al.* (US PAP 2004/0139178) and *Cochran, et al.* (US PAP 2002/0161867); and

II. Claims 28 and 36 are properly rejected under 35 U.S.C. § 103(a) in view of *Mendez, et al., Cochran, et al.* and *Wendt, et al.* (US Patent 6,067,558).

7. Argument

In this portion of the Appeal Brief, arguments are provided. Notably, wherever applicable, Applicant maintains previous arguments for patentability provided in responses to Office Actions.

I. Rejections in view of *Mendez, et al.* and *Cochran, et al.*

Independent claims 21 and 29 were rejected in view of *Mendez, et al.* and *Cochran, et al.* Applicants respectfully submit that the rejections of claims 21 and 29 are improper and should be withdrawn.

A. The applied art fails to disclose all features of each of claims 21 and 29

Claim 21 recites:

A system for configuring a network device coupled to a local network, comprising:

configuration server coupled to a network, the configuration server generating a web page that enables access to ***a configuration applet****;*

node coupled to the network and the local network, the node including a web browser that enables ***a user to load the configuration applet from the configuration server onto the node via the network by accessing the web page such that the configuration applet when executing on the node searches the local network for the***

***network device**, the web browser enabling the user **to generate a set of network configuration parameters** for the network device under control of the configuration server by communicating with the configuration server via the network.*

In an embodiment described in the filed application in the paragraph beginning at page 5, line 29, a function of the configuration applet is to search for network devices that can be configured:

> "The node 12 includes a set of hardware/software resources for executing a remote configuration applet 20 and a web browser application 22. The remote **configuration applet 20 searches the local network 50 for network devices such as the network device 40 that are capable of being configured**. The remote configuration applet 20 notifies the configuration server 10 via the communication network 30 when the network device 40 is found. The network device 40 may be undergoing an initial configuration or an update to its configuration." (Emphasis provided).

In rejecting claim 21, the Office Action directs Applicants to paragraph [0050] of *Mendez, et al.* While this portion of the applied art does disclose a configuration applet, the applets are instantiated in the **operating system 380** of a **global server**. By contrast, the configuration applets of claim 21 are loaded onto a node 12. Thus, the applied art fails to disclose a node of a local network as specifically recited in claim 21. For at least this reason, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 21.

Furthermore, and as conceded by the Examiner, *Mendez, et al.* fails to disclose a configuration applet loaded on the node when executing on the node *searches the local network for the network device*. In an attempt to cure this deficiency in *Mendez, et al.* the Office Action turns to paragraph [0040] and [0043] of *Cochran, et al.* (Kindly refer to page 5 of the final Office Action). Specifically, the Office Action states:

> *"Cochran* teaches that the computing device 14 loads a configuration assembly 12 from a device over a network to facilitate a search on the local network for the network device [see paragraph 0040, web pages, paragraph 0043, searching the network to locate the device], the web browser enabling the user to generate a set of network configuration parameters for the network device under control of the

configuration server by communicating with the configuration server via the network [see paragraphs 42-43 — the device configuration assembly 12 is displayed to the user and allows user to select the desired communication interfaces from the address search option, i.e., enables user to generate (select) network configuration parameters (desired communication interface) for the network device (device)] in order to provide a system/method for networking a desired device, by electronically locating a desired device on a network, and remotely configuring operational parameters of the desired device via the local network."

Paragraph [0033] of *Cochran, et al.* describes the use of a device configuration system 10 that utilizes a device configuration assembly 12 to configure one or more computing devices 26-42. Notably, the addresses of the computing devices are listed and therefore are known.

Paragraph [0040] of *Cochran, et al.* describes the use of the device configuration assembly 12 to identify a desired computing device to initiate communication between the device and the remote configuration assemblies 92, 94, which are databases and software applications 124, 126. An interactive communication between the desired device and the remote configuration assemblies accords the ability of the device to access web pages.

Paragraph [0042] of *Cochran, et al.* describes access of the device configuration assembly 12 by a computing device 14 to identify and configure a desired device. A user interface 132 includes a device list 134. The device configuration assembly detects **communication interfaces** disposed in the device 14. The detected interfaces may be displayed to a user via the interface 132. From an address search option 138, a user can select a desired communication interface.

Paragraph [0043] of *Cochran, et al.* describes table 146 which includes a variety of network information for the detected communications interfaces. As described in the final sentence of this paragraph, a user is accorded control over the specific network interface used and the search engine used by the device configuration assembly 12 to locate the desired device.

Thus, the portions of *Cochran, et al.* relied upon in the rejection of claim 21 describe the selection of devices from a list of addresses by the configuration assembly

12, and the options accorded a user in the selection of a desired device. The Office Action asserts that "the device configuration assembly 12 is displayed to the user and allows user to select the desired communication interfaces from the address search option, i.e., enables user to generate (select) network configuration parameters (desired communication interface) for the network device ." Thus, the Office Action is attempting to equate the selection of a communications interface from a list of interfaces. Applicants respectfully disagree.

First, the interface list does not comprise or equate to ***network configuration parameters***. These are merely interfaces (e.g., network cards) of the computing device 14. The device configuration assembly 12 includes a device configuration program; but there is no disclosure of the interfaces being used for configuration and certainly no disclosure of ***generating of a set of network configuration parameters*** by a user. Second, even assuming arguendo that the interfaces were network configuration parameters, Applicants respectfully submit that the selection of an interface from a list cannot be equated properly to the generation thereof. To wit, once provided on the list, the parameter is generated; its selection is nothing more than an extraction.

Finally, there is no disclosure of an applet in *Cochran, et al.*, and especially no disclosure of a ***configuration applet when executing on the node searches the local network for the network device***.

For at least the reasons set forth above, Applicants respectfully submit *Cochran, et al.* fails to cure the deficiencies of *Mendez, et al.* As such, the applied art fails to disclose at least one feature of claim 21.

Claim 29 recites:

A method for configuring a network device coupled to a local network, comprising:

generating a web page that enables access to a configuration applet via a network;

loading the configuration applet via the network by accessing the web page such that the configuration applet when executing searches the local network for the network device;

generating a set of network configuration parameters for the network device under control of a configuration server by communicating with the configuration server via the network.

The Office Action treats claims 21 and 29 collectively in the rejection. Applicants respectfully submit for at least the same reasons set forth above, the rejection of claim 29 is improper. Notably, and as discussed above, neither *Mendez, et al.* nor *Cochran, et al.* disclose features of claim 29 such as loading a configuration applet by accessing web pages such that *the configuration applet when executing searches the local network for the network device.*

For at least the reasons set forth above, Applicants respectfully submit *Cochran, et al.* fails to cure the deficiencies of *Mendez, et al.* As such, the applied art fails to disclose at least one feature of claim 29.

B. The combination of submit *Mendez, et al.* and *Cochran, et al.* is improper

In combining the two references in the rejection, the Office Action states:

> "One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous for the system of *Mendez* to be able to search the local network for the network device in order to allow a user to determine whether the devices exists on the local network by searching the desired devices before configuring the network device. It is for this reason that one of ordinary skill in the art would have been motivated to implement system of searching the local network before configuring the network device."

In *KSR Int'l Co. v. Teleflex Inc.,* 127 S. Ct. 1727; 82 U.S.P.Q.2D 1385 (2007), the Court stated "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964)))." Moreover, if there is no suggestion to combine the teachings of the applied art,

other than the use of Applicants' invention as a template for its own reconstruction, a rejection for obviousness is improper. *Ex parte Crawford, et al.* Appeal 20062429, May 30, 2007. In furtherance to the need for the suggestion to combine the teachings of the applied art, it is established that rejections on obviousness grounds cannot be sustained by mere conclusory statements: instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex*, 127 S. Ct. at 1741.

Applicants respectfully submit that both hindsight reasoning and a tenuous motivation have been provided in combining *Mendez, et al.* and *Cochran, et al.* As to the former, as discussed above, there is no disclosure in *Mendez, et al.* of *executing searches the local network for the network device*. *Cochran, et al.* lacks the disclosure of an applet and especially a configuration applet as specifically claimed. But for the availability of the claims as templates for their reconstruction would one seek to merge the two disclosures with selected extractions from each of *Mendez, et al.* and *Cochran, et al.* Rather, Applicants respectfully submit that the Examiner is attempting to infer a search capability into a configuration applet when *Cochran, et al.* does not disclose even the applet therefore. Moreover, no basis for transplanting the search function into the configuration applet of *Mendez, et al.* that suffices to provide an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness has been set forth in the Office Action.

Accordingly, and for at least the reasons set forth above, Applicants respectfully submit that the requisite basis of support for combining the applied art has not been provided. As such, the rejection under 35 U.S.C. § 103(a) are improper.

C. Claims 21-27 and 29-35 are patentable over the applied art

For at least the reason set forth above, claims 21 and 29 are patentable over the applied art. Claims 22-27 and 31-35, which depend from claims 21 and 29, respectively, are patentable for at least the same reasons and in view of their additionally recited subject matter.

II. Rejections in view of *Mendez, et al.*, *Cochran, et al.* and *Wendt, et al.*

While Applicants in no way concede the propriety of the rejections of claims 29 and 36, these claims depend from claims 21 and 29, respectively. As such, claims 29 and 36 are patentable for at least the same reasons as claims 21 and 29, and in view of their additionally recited subject matter.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Agilent Technologies, Inc.

by: William S. Francos (Reg. No. 38,456)
Date: January 31, 2009

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Appendix

Claims on Appeal

21. A system for configuring a network device coupled to a local network, comprising:

configuration server coupled to a network, the configuration server generating a web page that enables access to a configuration applet;

node coupled to the network and the local network, the node including a web browser that enables a user to load the configuration applet from the configuration server onto the node via the network by accessing the web page such that the configuration applet when executing on the node searches the local network for the network device, the web browser enabling the user to generate a set of network configuration parameters for the network device under control of the configuration server by communicating with the configuration server via the network.

22. The system of claim 21, wherein the configuration server generates a set of configuration web pages that enable the user to obtain the network configuration parameters for the network device via the web browser.

23. The system of claim 22, wherein the configuration web pages enable the user to enter a set of addresses on the local network for the network configuration parameters.

24. The system of claim 22, wherein the configuration web pages include a web page that enables the user to enter an address for the network device.

25. The system of claim 22, wherein the configuration web pages include a web page that enables the user to enter an address for a proxy server on the local network.

26. The system of claim 22, wherein the configuration web pages include a web page that enables the user to enter an address for the configuration server.

27. The system of claim 22, wherein the configuration applet executing on the node

transfers the network configuration parameters to the network device via the local network.

28. The system of claim 21, wherein the configuration applet searches the local network for the network device by transferring a multi-cast query message via the local network and detecting responses.

29. A method for configuring a network device coupled to a local network, comprising:

generating a web page that enables access to a configuration applet via a network;

loading the configuration applet via the network by accessing the web page such that the configuration applet when executing searches the local network for the network device;

generating a set of network configuration parameters for the network device under control of a configuration server by communicating with the configuration server via the network.

30. The method of claim 29, wherein generating a set of network configuration parameters comprises generating a set of configuration web pages that enable a user to obtain the network configuration parameters for the network device via a web browser.

31. The method of claim 30, wherein generating a set of configuration web pages includes generating a set of configuration web pages that enable the user to-enter a set of addresses on the local network for the network configuration parameters.

32. The method of claim 30, wherein generating a set of configuration web pages includes generating a web page that enables the user to enter an address for the network device.

33. The method of claim 30, wherein generating a set of configuration web pages

includes generating a web page that enables the user to enter an address for a proxy server on the local network.

34. The method of claim 30, wherein generating a set of configuration web pages includes generating a web page that enables the user to enter an address for the configuration server.

35. The method of claim 30, wherein the configuration applet when executing transfers the network configuration parameters to the network device via the local network.

36. The method of claim 29, wherein the configuration applet searches the local network for the network device by transferring a multi-cast query message via the local network and detecting responses.

Appendix

Evidence (None)

Appendix

Related Proceedings (None)